

ESTTA Tracking number: **ESTTA728361**

Filing date: **02/19/2016**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Sinclair Pharmaceuticals Limited
Granted to Date of previous extension	02/21/2016
Address	Office Village, Chester Business Park Chester, CH4 9QZ UNITED KINGDOM
Attorney information	Gregory N. Owen Owen, Wickersham & Erickson, P.C. 455 Market Street, Suite 1910 San Francisco, CA 94105 UNITED STATES gowen@owe.com, bdunne@owe.com Phone:(415) 882-3200

Applicant Information

Application No	86585402	Publication date	08/25/2015
Opposition Filing Date	02/19/2016	Opposition Period Ends	02/21/2016
Applicant	Phoenix Group LLC 1221 Kapiolani Blvd., Suite 1025 Honolulu, HI 96814 UNITED STATES		

Goods/Services Affected by Opposition

Class 044. First Use: 0 First Use In Commerce: 0
All goods and services in the class are opposed, namely: Cosmetic and plastic surgery

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
Other	Trademark Act Section 43(a) False designation of origin

Marks Cited by Opposer as Basis for Opposition


U.S. Registration No.	3179140	Application Date	01/31/2006
Registration Date	12/05/2006	Foreign Priority Date	NONE
Word Mark	SILHOUETTE SUTURE		

Design Mark	SILHOUETTE SUTURE
Description of Mark	NONE
Goods/Services	Class 010. First use: First Use: 2005/10/19 First Use In Commerce: 2005/10/19 SUTURES AND INSTALLATION NEEDLES THEREFOR

U.S. Registration No.	3416606	Application Date	07/30/2007
Registration Date	04/29/2008	Foreign Priority Date	NONE
Word Mark	SILHOUETTE LIFT		
Design Mark	SILHOUETTE LIFT		
Description of Mark	NONE		
Goods/Services	Class 010. First use: First Use: 2007/05/15 First Use In Commerce: 2007/05/15 Sutures, namely, sutures for wound closure, tissue approximation, tissue support, suspension and fixation, and installation needles therefor		

U.S. Registration No.	4838785	Application Date	08/08/2014
Registration Date	10/27/2015	Foreign Priority Date	02/10/2014
Word Mark	SILHOUETTE SOFT		
Design Mark	SILHOUETTE SOFT		
Description of Mark	NONE		
Goods/Services	<p>Class 003. First use: First Use: 0 First Use In Commerce: 0 Soaps, creams, gels, moisturizers, lotions and cosmetics for use in connection with and following cosmetic procedures; none of the aforesaid for use in relation to the hair and scalp</p> <p>Class 010. First use: First Use: 0 First Use In Commerce: 0 Sutures, namely, sutures for wound closure, tissue approximation, tissue support, suspension and fixation, and installation needles therefor</p> <p>Class 044. First use: First Use: 0 First Use In Commerce: 0 Medical services, namely, cosmetic surgery services, cosmetic body care services, cosmetic face care services; cosmeticskin care services and non-invasive cosmetic medical procedures; hygienic and beauty care for human beings except for the hair and scalp, namely, cosmetic surgery services, cosmetic body care services, cosmetic face care services, cosmeticskin care services and non-invasive cosmetic medical procedures</p>		

U.S. Application No.	86373714	Application Date	08/21/2014
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	SILHOUETTE INSTALIFT		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 010. First use: First Use: 0 First Use In Commerce: 0 SUTURES FOR COSMETIC PROCEDURES

Attachments	76654334#TMSN.png(bytes) 76680016#TMSN.png(bytes) 79153287#TMSN.png(bytes) 86373714#TMSN.png(bytes) Notice of Opposition-2016 0219.pdf(476980 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Gregory N. Owen/
Name	Gregory N. Owen
Date	02/19/2016

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the re matter of Trademark Application

Applicant: Phoenix Group LLC dba Breast Implant Center of Hawaii
Serial No.: 86-585402
Filed: April 2, 2015
Mark: ULTIMATE SILHOUETTPLASTY
Publication Date: August 25, 2015

SINCLAIR PHARMACEUTICALS
LIMITED,

Opposer,

v.

PHOENIX GROUP LLC dba BREAST
IMPLANT CENTER OF HAWAII,

Applicant.

NOTICE OF OPPOSITION

Opposer, Sinclair Pharmaceuticals Limited (hereinafter, "Sinclair"), believes that it will be damaged by registration of the mark ULTIMATE SILHOUETTPLASTY set forth in Application Serial No. 86-585402, published in the *Official Gazette* on August 25, 2015, and hereby opposes the same pursuant to Section 13(a) of the Trademark Act of 1946, as amended (the Lanham Act), 15 U.S.C. § 1063(a).

As grounds for this Opposition, Sinclair alleges on knowledge as to itself, and otherwise upon information and belief, as follows:

1. Sinclair Pharmaceuticals Limited is a United Kingdom company incorporated under the laws of England and Wales, with its principal place of business located at Office

Village, Chester Business Park, Chester, UNITED KINGDOM CH49QZ117.

2. Sinclair is an innovative medicinal and aesthetic dermatological company and the manufacturer of the SILHOUETTE line of skin-care solutions. Sinclair has adopted a family of marks featuring the first word “Silhouette” (the “SILHOUETTE Family of Marks”). These marks, which are used in connection with Sinclair’s highly successful cosmetic surgery products, have developed valuable goodwill and consumer recognition.

3. Since at least as early as October 2005, Sinclair and its predecessors in interest have been using “SILHOUETTE” marks in association with suture and cosmetic surgery products. Soon Sinclair will introduce to the U.S. market a non-invasive cosmetic procedure under the mark SILHOUETTE SOFT.

4. As a result of Sinclair’s use, advertising, and promotion of the SILHOUETTE Family of Marks starting at least as early as October 2005, marks with the word “SILHOUETTE” associated with cosmetic surgery have become distinctive indicators of the origin of Sinclair’s cosmetic surgery products and have become valuable symbols of Sinclair’s goodwill.

5. The marks that make up the SILHOUETTE Family of Marks are composed and used in such a way that the relevant consuming public associates not only the individual SILHOUETTE-formative marks with Sinclair, but also associates the common characteristic of the family, the first word “SILHOUETTE,” with Sinclair.

6. Sinclair’s established SILHOUETTE Family of Marks is evidenced by the following federal registrations and application:

Mark/Name	App. No./Reg. No.	App./Reg. Date	Full Goods/Services
SILHOUETTE SUTURE	SN: 76654334 Reg: 3179140	January 31, 2006 December 5, 2006	(Int’l Class: 10) Sutures and installation needles

Mark/Name	App. No./Reg. No.	App./Reg. Date	Full Goods/Services
		First Use: October 19, 2005	therefor
SILHOUETTE LIFT	SN: 76680016 Reg: 3416606	July 30, 2007 April 29, 2008 First Use: May 15, 2007	(Int'l Class: 10) Sutures, namely, sutures for wound closure, tissue approximation, tissue support, suspension and fixation, and installation needles therefor
SILHOUETTE SOFT	SN:79153287 Reg: 4838785	August 8, 2014 October 27, 2015 Section 44(e)	(Int'l Class 3) Soaps, creams, gels, moisturizers, lotions and cosmetics for use in connection with and following cosmetic procedures; none of the aforesaid for use in relation to the hair and scalp (Int'l Class: 10) Sutures, namely, sutures for wound closure, tissue approximation, tissue support, suspension and fixation, and installation needles therefor (Int'l Class 44) Medical services, namely, cosmetic surgery services, cosmetic body care services, cosmetic face care services; cosmetic skin care services and non-invasive cosmetic medical procedures; hygienic and beauty care for human beings except for the hair and scalp, namely, cosmetic surgery services, cosmetic body care services, cosmetic face care services, cosmetic skin care services and non-

Mark/Name	App. No./Reg. No.	App./Reg. Date	Full Goods/Services
			invasive cosmetic medical procedures
SILHOUETTE INSTALIFT	SN: 86373714	August 21, 2014 Section 1(b)	(Int'l Class: 10) Sutures for cosmetic procedures

7. Each of the registrations listed above is in all respects valid and subsisting and is presumptive evidence of Sinclair's ownership and exclusive right to use the registered marks in commerce in association with the goods and services recited therein.

8. The SILHOUETTE SUTURE and SILHOUETTE LIFT registrations are incontestable. The SILHOUETTE SOFT registration is based upon European Community Trade Mark Registration No. 1219022 pursuant to Lanham Act Section 44(e); Sinclair has a continuing *bona fide* intent to use the mark in the U.S. in association with the goods and services recited in the registration. Likewise, Sinclair has a continuing *bona fide* intent to use the SILHOUETTE INSTALIFT trademark in the U.S. in association with the goods recited in the application.

9. Upon information and belief, applicant Phoenix Group LLC dba Breast Implant Center of Hawaii ("Applicant") is a corporation organized under the laws of Delaware, with an address at 1221 Kapiolani Blvd., Suite 1025, Honolulu, Hawaii 96814.

10. On April 2, 2015, Applicant filed Application Serial Number 86-585402 for the mark ULTIMATE SILHOUETTPLASTY for *cosmetic and plastic surgery* services in Class 44. The application is based upon intended use pursuant to Section 1(b) of the Trademark Act, 15 U.S.C. §1051(b). Sinclair objects to the registration of ULTIMATE SILHOUETTPLASTY for the recited services.

11. Upon information and belief, Sinclair had garnered significant goodwill in the SILHOUETTE Family of Marks well before Applicant's application filing date and well before any date of first use upon which Applicant can rely.

12. Applicant's ULTIMATE SILHOUETTPLASTY application is similar in sight, sound, and commercial impression to Sinclair's SILHOUETTE Family of Marks.

13. Applicant's ULTIMATE SILHOUETTPLASTY mark is substantially similar to Sinclair's previously adopted SILHOUETTE Family of Marks and, when applied to proximate cosmetic surgery goods and services, it is likely to cause confusion, mistake or deception within the meaning of Section 2(d) of the Trademark Act.

14. On information and belief, Applicant's and Sinclair's goods and services will be, or are being, offered in the United States to the same class of customers through the same or similar channels of trade; and the services Applicant intends to offer, or may currently be offering, in connection with the ULTIMATE SILHOUETTPLASTY mark are so closely related, as well as being within Sinclair's natural scope of expansion, to those Sinclair offers in connection with its SILHOUETTE Family of Marks that the public is likely to be confused, be deceived, or to incorrectly assume that Applicant's services are offered, sponsored, or approved by Sinclair, or that Applicant is some way affiliated with Sinclair, all to Sinclair's irreparable harm.

15. Additionally, on information and belief, Applicant's mark is a false designation of origin, which is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of Applicant with Sinclair and as to the origin, sponsorship, or approval of Applicant's services by Sinclair. Applicant's use of the ULTIMATE SILHOUETTPLASTY mark will result in a misrepresentation of the nature, characteristics, or

qualities of Applicant's business and related services in violation of Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a)(1), all to Sinclair's irreparable harm.

16. If Applicant is granted a registration for the application herein opposed, it would thereby obtain at least *prima facie* exclusive right to use ULTIMATE SILHOUETTEPLASTY for services similar and/or highly related to the goods and services offered or intended to be offered by Sinclair in connection with its SILHOUETTE Family of Marks. Such registration would be a source of damage and injury to Sinclair.

17. Sinclair is likely to be damaged by the registration sought by Applicant because such registration will support and assist Applicant in the confusing and misleading use of Applicant's mark, and will give color of exclusive statutory rights to Applicant in violation and derogation of the prior and superior rights of Sinclair.

18. For the reasons set forth herein, Sinclair believes that Applicant is not entitled to register its mark because of Sinclair's prior rights in its the SILHOUETTE Family of Marks, as set forth above. The application should therefore be denied in accordance with Sections 2(d) and 43(a) of the Lanham Act, 15 U.S.C. §§ 1052(d), 1125(a).

WHEREFORE, Sinclair prays that this opposition be sustained in its favor and that registration of the service mark ULTIMATE SILHOUETTPLASTY and specified in Application Serial No. 86-585402 be refused in accordance with the provisions of the Trademark Act.

OWEN, WICKERSHAM & ERICKSON, P.C.

Dated: February 19, 2016

By:



Gregory N. Owen
Attorneys for Opposer
Sinclair Pharmaceuticals Limited

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CERTIFICATE OF SERVICE


I hereby certify that a true and complete copy of the foregoing:

NOTICE OF OPPOSITION

has been served on Applicant's counsel via first class U.S. mail, postage prepaid, to the following address:

Alec P. Rosenberg
Ross Q. Panko
Arent Fox LLP
1717 K Street NW
Washington, D.C. 2008-5343

Dated: February 19, 2016



B. C. Dunne